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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,580	05/26/2005	David William Trepess	282534US8XPCT	2158

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CHEMPAKASERIL, ANN J

ART UNIT	PAPER NUMBER
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2166

NOTIFICATION DATE	DELIVERY MODE
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12/31/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/536,580

Applicant(s)

TREPESS ET AL.

Examiner

Ann J. Chempakaseril

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/26/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In response to the election requirement, applicants elected claims 24-26, and 29-32 are pending in this office action. Upon further communication with the applicant on December 13, 2007, applicant has also withdrawn claims 29-32 since they are dependant on the withdrawn claims

Claims 24-26 are pending in this office action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-26 and 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed subject is rejected under 35 USC 101 for being "software per se".

The claimed invention is addressed to "a graphical user interface" that can be interpreted as an icon or application within the computer system, rather than referring to the system as a physical object. The claimed invention is also addressed to "computer software having program code", and "a providing medium" that are not a hardware system but is a software. Accordingly, the claim becomes nothing more than sets of software instructions which are "software per se".

"Software per se" is non-statutory under 35 USC 101 because it is merely a set instructions without any defined tangible output or tangible result being produced. The

requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998)

Claims 30 and 32 are not limited to tangible embodiments. The medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., removable storage and hard disk drive) and intangible embodiment(e.g., a carrier-wave signal). These particular sections in the disclosure refer to "communication media" and/or "transmission media". As such, these claims are not limited to statutory subject matter and are therefore non-statutory.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because of its length. Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show essential details as described in the specification. Fig. 1 has boxes connected by lines that are assumed to be steps but does not show any detail to facilitate understanding of this drawing. Figures 7-9 are schematic representation to that illustrate display screens providing a user interface to access information. The schematic representations are Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 24 and 26 objected to because of the following informalities:

As per claim 24 and 26, please fix the typo "characterising" with "characterizing".

Appropriate correction is required.

As per claim 25, replace there is insufficient antecedent basis for "more than one information feature" It is unclear if it refers to "characterising information feature" mentioned in the previous claim. Please make the necessary changes to make this limitation clearer.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5893095 issued to Jain et al.

As per claim 24, Jain discloses a graphical user interface for specifying a search query for searching a set of information items, the information items each having a set of characterising information features, the interface comprising rows of fields, each field providing a facility for selecting information items from the set of information items, each row defining a search condition for forming a search query, in accordance with a different type of characterising information feature associated with said row (FIG. 3 is an

exemplary screen display sees during execution of the alphanumeric query input module 106, or subsequent to execution of the query canvas module 108 or image browsing module 110 shown in FIG. 1A.)

As per claim 25, Jain discloses wherein a plurality of information items may be selected for each row, and if more than one information feature is provided in each row, then the conditions for the search query are combined in accordance with user specified Boolean operators. (FIG. 3 is an exemplary screen display sees during execution of the alphanumeric query input module 106, or subsequent to execution of the query canvas module 108 or image browsing module 110 shown in FIG. 1A. The search criteria are Boolean operators to combine the different conditions of the search query)


As per claim 26, Jain discloses wherein the characterising information features are at least one of metadata, video images and audio metadata. (Referring to FIG. 3, an exemplary screen display 200 of a Query Window will be described. The Query Window or form 200 is provided to specify alpha-numeric information 201 such as keywords, dates, file name masks, project or client names, and so forth. [Col 11, lines 15-35])

Contact Information

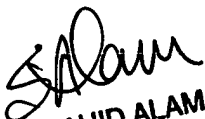
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Ann J Chempakaseril
Examiner
Art Unit 2166

December 19, 2007


SHAHID ALAM
PRIMARY EXAMINER